



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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MEMORANDUM

DATE: October 29, 2004

TO: Patent Examining Corps

FROM: /s/
Stephen G. Kunin
Deputy Commissioner
for Patent Examination Policy

SUBJECT: **Termination of transitional practice of supplying a copy of a provisional application relied upon to give prior art effect under 35 U.S.C. § 102(e) to a reference applied in a rejection**

Recently, Internet access to provisional applications that are relied upon for their earlier filing dates in U.S. patent application publications or U.S. patents became available to the public via Public PAIR (Patent Application Information Retrieval). As a result, the transitional practice for supplying a copy of a provisional application relied upon to give prior art effect under 35 U.S.C. § 102(e) to a reference applied in a rejection has ended.

The transitional practice began in December of 2003, and required examiners to: (1) list on the PTO-892 form the provisional application number that gives prior art effect to an applied reference; and (2) include form paragraph 7.82.02 in the written Office action. Now that the transitional practice has ended, these requirements are rescinded.

Accordingly, form paragraph 7.82.02 will soon be removed from OACS.

Although the transitional practice has ended, whenever the examiner has a copy of a provisional application relied upon for prior art effect of an applied reference, the examiner may still include the copy with the Office action submitted for mailing (e.g., in the red Action folder). When a copy of a provisional application is included with the Office action submitted for mailing, the examiner should list the provisional application number in the bottom section of the PTO-892 form under the heading "Non-Patent Documents."

If applicant requests a copy of a provisional application relied upon for prior art effect of a reference applied in an Office action, applicant should be referred to the Public PAIR website at <http://portal.uspto.gov/external/portal/pair> for viewing and/or printing the provisional application. If applicant cannot view or print the provisional application from the Public PAIR website, applicant can still use the Public PAIR website to order a copy of the provisional application. Whether the order for the provisional application copy is placed with the Office of Public Records directly from the Public PAIR website, or by mail (using Mail Stop Document Services), the order requires the fee under 37 CFR 1.19(b)(1).